

<p>This Opinion is Not a Precedent of the TTAB</p>

Mailed: February 13, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Express, LLC

v.

EXP613, LLC

Opposition Nos. 91194918 (parent), 91198762,
91199874, 91199875, 91208967, and 91209980¹

Frank J. Colucci of Colucci & Umans for Express, LLC.
C. Andrew Im of IM IP Law PLLC for EXP613, LLC.

Before Bergsman, Wolfson, and Hightower,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

¹ The first four proceedings identified in the above caption were consolidated on June 22, 2011. *See* TTABVUE 13. The latter two proceedings were joined in the consolidation on July 16, 2013. *See* TTABVUE 53. Since the consolidation in July 2013, all orders and filed papers pertaining to any of the consolidated proceedings have been entered in Opp. No. 91194918, the parent proceeding docket. All references to TTABVUE docket entries correspond to those in Opp. No. 91194918 unless otherwise specifically noted.

Citations to the record will be to TTABVUE, the docket history system for the Trademark Trial and Appeal Board. Exhibits to testimony will be identified by their initial page number in TTABVUE. Because the Board primarily uses TTABVUE in reviewing evidence, the Board prefers that citations to material or testimony in the record that has not been designated confidential include the TTABVUE docket entry number and the TTABVUE page number. For material or testimony that has been designated confidential and which does not appear on TTABVUE, the TTABVUE docket entry number where the public (redacted) version of such material or testimony is located should be included in any citation. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

Express, LLC (“Opposer”) opposes six applications filed by EXP613, LLC (“Applicant”) to register the standard character mark EXP for a wide variety of goods and services. The applications and corresponding oppositions are:

Application Serial No. 77286020 (Opposition No. 91194918)²

Products for perfuming the atmosphere, namely, scented room sprays; aromatic oils, namely, scented oils used to produce aromas when heated; potpourris and perfumed incense; sachets in International Class 3;

Purses, backpacks, handbags, duffel bags, briefcases, wallets, business card cases; leather and imitations of leather, and goods made of these materials, namely, purses, backpacks, handbags, duffel bags, business card cases and wallets in International Class 18; and

Ethnic clothing, namely, dresses, jackets, pants, scarves, shirts, skirts, undergarments, vests; footwear; headgear, namely, hats in International Class 25.

Application Serial No. 77799392 (Opposition No. 91198762)³

Retail store services featuring a wide variety of consumer goods of others in the field of bags, furniture, home décor, jewelry, purses, and watches; Computerized on-line ordering featuring general merchandise and general consumer goods in the field of bags, furniture, home décor, jewelry, purses, and watches; advertising, marketing and promotion services in the field of bags, furniture, home décor, jewelry, purses, and watches; bringing together, for the benefit of others, a wide variety of goods enabling customers to view and purchase those goods in the field of bags, furniture, home décor, jewelry, purses, and watches in International Class 35.

² Application Serial No. 85443655, filed on September 21, 2007, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on a bona fide intent to use the mark in commerce. The application also covers goods in Classes 4, 19, 20, 21, and 27 that are not the subject of the opposition. See TTABVUE 55, “Opposer’s Motion to Withdraw Classes” and TTABVUE 56, “Amended Notice of Opposition.”

³ Application Serial No. 77799392, filed August 7, 2009, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on a bona fide intent to use the mark in commerce.

Application Serial No. 85095689 (Opposition No. 91199874)⁴

[The same goods already listed above in Class 3] and joss sticks and scented wood in International Class 3.

Application Serial No. 85095702 (Opposition No. 91199875)⁵

[The same goods already listed above in Class 18] and canes and walking sticks in International Class 18.

Application Serial No. 85627524 (Opposition No. 91208967)⁶

Fashion information; Online social networking services provided through a fashion community website; Providing news and information in the field of fashion; Provision of a web site featuring information on fashion in International Class 45.

Application Serial No. 85668535 (Opposition No. 91209980)⁷

On-line wholesale store services featuring a wide variety of consumer goods, including, furniture, home decor, bags, clothing, footwear, headgear, jewelry, purses, watches, cushion covers, scented oils, hair accessories, personal care products, wall decor, socks vases, rugs and candles; Wholesale ordering services in the field of a wide variety of consumer goods, including, furniture, home decor, bags, clothing, footwear, headgear, jewelry, purses, watches, cushion covers, scented oils, hair accessories, personal care products, wall decor, socks vases, rugs and candles in International Class 35.

As grounds for opposition in each proceeding, Opposer alleges priority and likelihood of confusion between its previously used marks EXPRESS and EXP, its registered marks containing the term EXPRESS, by itself or with other matter, and

⁴ Application Serial No. 85095689, filed July 29, 2010, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on a bona fide intent to use the mark in commerce.

⁵ Application Serial No. 85095702, filed July 29, 2010, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on a bona fide intent to use the mark in commerce.

⁶ Application Serial No. 85627524, filed May 16, 2012, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on a bona fide intent to use the mark in commerce.

⁷ Application Serial No. 85668535, filed July 3, 2012, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), reciting October 31, 2002 as the date of first use and date of first use in commerce.

Applicant's mark EXP. Specifically, Opposer alleges that it "has used and advertised its EXPRESS Marks continuously and extensively since 1983" and "has used the mark EXP since 1986";⁸ that it is the owner of several registrations for the marks EXPRESS,⁹ EXPRESS MEN,¹⁰ EXPRESS RESERVE,¹¹ and EXP PERK,¹² collectively covering various goods including clothing and retail store services; and that Applicant's mark EXP so resembles Opposer's previously used EXP and EXPRESS marks that confusion, deception or mistake among purchasers is likely to result under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).¹³

⁸ Amended notice of opposition pp. 5 and 7, 56 TTABVue 6 and 8.

⁹ Opposer pleads five registrations for the mark EXPRESS: Reg. No. 1120073 for "sweaters, knit tops, blouses, pants, sport jackets, shirts, and skirts" (renewed), Reg. No. 2290570 for "shorts, tank tops and t-shirts" (renewed), Reg. No. 2484122 for "sunglasses; jewelry; purses and handbags; hosiery, tights and socks; hair clips" (issued September 4, 2001; Section 8/15 affidavit accepted and acknowledged), Reg. No. 3797700 for "hair accessories, namely, hair ornaments, hair slides, hair bands, hair bows, and hair grips; retail store services featuring jewelry and hair accessories" (issued June 10, 2010), and Reg. No. 4016278 for "retail store services, mail order catalog services, and on-line retail store services all featuring clothing, clothing accessories, fashion accessories, men's accessories, namely, bags, small leather goods, jewelry, and eyewear, lingerie, undergarments, hosiery, personal care products, and footwear" (issued August 23, 2011).

¹⁰ Reg. No. 2754311 for "retail store services featuring personal care products and clothing" (issued August 19, 2003; Section 8/15 affidavit accepted and acknowledged).

¹¹ Reg. No. 3829646 for "personal care products, namely, cologne" (issued August 3, 2010).

¹² Reg. No. 4030937 for "downloadable software in the nature of a mobile application for providing links to third-party computer servers for the purpose of allowing users to receive retail promotions in the field of men's and women's clothing, consumer coupons, notice of retail clothing events and earn and redeem rewards by ordering clothing online" (issued September 27, 2011).

¹³ Opposer also pleaded priority based on common-law rights in the marks EXP, 576 EXPRESS, 589 EXPRESS and EXPLife, and several additional registrations that have been cancelled. We have considered the evidence regarding the unregistered marks, but the cancelled registrations have no probative value and therefore we have not considered them. *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1487 n.9 (TTAB 2007).

As a second ground for opposition, Opposer alleges that its EXPRESS mark became famous prior to the filing date of Applicant's application, and that Applicant's use and registration of its mark **EXP** is "likely to, and will dilute, blur and erode the distinctiveness of Opposer's famous EXPRESS mark, and/or damage the goodwill associated with the EXPRESS mark."¹⁴

As an additional ground for Opposition No. 91208967, Opposer pleaded that at the time Applicant filed the involved application, it lacked a *bona fide* intent to use the EXP mark in commerce in association with the "fashion information services" identified in the application. The claim was not pursued in Opposer's brief and we therefore consider this claim to be waived. *Cf. Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005) (where opposer presented no arguments in its brief regarding the claim of dilution, opposer is deemed to have waived the claim).

By its answers, Applicant denied the salient allegations in each of the oppositions.

Record

The pleadings for each opposition and, by operation of the Trademark Rules, the files of the subject applications are of record. Trademark Rule 2.122, 37 C.F.R. § 2.122.

During its trial period, Opposer introduced the following testimony and evidence:


¹⁴ 56 TTABVUE 10.

1. Trial testimony of Colin Campbell (“Campbell”), Opposer’s Executive Vice-President of Sourcing and Production, with Exhibits;
2. Trial testimony of Douglas Focht (“Focht”), Opposer’s Art Director in the Marketing Department, with Exhibits;
3. Trial testimony of Paul Schwartzberg (“Schwartzberg”), Opposer’s Director of Men’s Graphics and CAD Design, with Exhibits;
4. Trial testimony of Lydia DeCarlo (“DeCarlo”), Opposer’s Finance Director of Financial Planning and Analysis, with Exhibits; and
5. Opposer’s Rebuttal Notice of Reliance filed June 12, 2014 featuring excerpts of the October 28, 2013 discovery deposition of Andrew Altschuler (“Altschuler Deposition”), Applicant’s President.¹⁵

Applicant introduced the trial testimony of Mr. Altschuler (“Altschuler Testimony”), with Exhibits.

Standing

Opposer has made its pleaded registrations of record by attaching to its amended notices of opposition printouts obtained from the Office’s Trademark Status & Document Retrieval (“TSDR”) database showing the registrations’ current status and title in Opposer. The registrations (for the marks EXPRESS, EXPRESS MEN, EXPRESS RESERVE, and EXP PERK) establish Opposer’s standing. Trademark Rule 2.122(d)(1); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). Opposer’s standing is further established by its pleading and proof of ownership of trademark application Serial No. 77733938

for the mark , which has been suspended pending disposition of Applicant’s application Serial No. 77286020 on the ground that should Applicant’s

¹⁵ Applicant refers to Mr. Altschuler as its sole member rather than as President.

mark issue, it could become the basis of a citation against Opposer's application based on likelihood of confusion under Section 2(d) of the Trademark Act. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

Because Opposer's pleaded EXPRESS registrations are of record, Section 2(d) priority is not an issue in this case as to that mark and the specific goods covered by those registrations.¹⁶ *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Opposer has also shown priority of use of its EXPRESS mark.

However, priority is in issue with respect to Opposer's mark EXP because it is unregistered.¹⁷ The following background information is necessary to determine priority. Opposer, founded in 1980, is a specialty fashion apparel retailer marketing

¹⁶ While we note Opposer's priority with respect to its registered marks EXPRESS MEN, EXPRESS RESERVE, and EXP PERK, we focus herein on Opposer's marks EXPRESS and EXP, as these are most similar to Applicant's mark EXP.

¹⁷ Priority is not in issue with respect to Opposer's registered mark EXP PERK (Reg. No. 4030937) as to the specific goods covered by that registration. However, we do not consider the marks EXP and EXP PERK to be legal equivalents, such that Opposer's use of the EXP mark may be tacked onto its registration for the EXP PERK mark.

We further note that Opposer bears the burden to establish priority with respect to the other marks for which it has alleged prior common law rights, namely, 576 EXPRESS, 589 EXPRESS, and EXPLife, but because Opposer's EXP mark is the most similar to Applicant's mark, we have focused our attention with respect to Opposer's unregistered marks on the mark EXP. If we find that there is a likelihood of confusion with the mark EXP, there is no need for us to consider the likelihood of confusion with the marks 576 EXPRESS, 589 EXPRESS, and EXPLife. Conversely, if we find there is no likelihood of confusion with the mark EXP, we would find no likelihood of confusion with the other marks as they merely incorporate EXP as part thereof. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

to women and men in the 18-27-year-old range.¹⁸ Since its inception, Opposer has sold men's and women's fashion apparel and accessories, such as watches, purses, sunglasses, ties, shoes, men's and women's underwear and personal care products under the EXPRESS mark.¹⁹ Opposer currently operates 600 stores in the United States.²⁰ Each store displays the EXPRESS mark on its exterior and within the store's interior.²¹ The EXPRESS mark was first used in the mid-1980's.²² There is no issue of priority with respect to Opposer's registered EXPRESS mark.

Opposer alleges prior use of both its mark EXPRESS and the mark EXP on its goods and services, and that each store carries apparel and other goods bearing the EXPRESS and EXP marks.²³ To prevail on its likelihood of confusion claim based on its common law rights in EXP, Opposer must prove that such rights were acquired before any date upon which Applicant may rely. Opposer's burden is to prove priority by a preponderance of the evidence. *Hydro-Dynamics Inc. v. George Putnam & Co.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987). Applicant may rely on the filing dates of its trademark applications as the constructive first use dates of those goods recited in the applications. *Zirco Corp. v. American Telephone and*

¹⁸ Campbell Test., p. 15, 62 TTABVUE 18; Focht Test., p. 7, 63 TTABVUE 10.

¹⁹ Campbell Test., p. 14, 62 TTABVUE 17 (noting that women's intimates have been discontinued but inventory may still be available in stores), Exhibit 5, 62 TTABVUE 176; Campbell Test., p. 69, 62 TTABVUE 72 (mentioning EXP watches). See also DeCarlo Test., p. 7, 65 TTABVUE 10 ("We sell fragrance, personal care, accessories, our jewelry, earrings, necklaces, scarves, bags, shoes....").

²⁰ Campbell Test., p. 11, 62 TTABVUE 14.

²¹ *Id.*; Exhibits 3 and 4, 62 TTABVUE 165, 172.

²² DeCarlo Test., p. 7, 65 TTABVUE 10; Campbell Test., p. 17, 62 TTABVUE 20; Focht Test., p. 8, 63 TTABVUE 11 ("about maybe '82.").

²³ Campbell Test., p. 68, 62 TTABVUE 71.

Telegraph Co., 21 USPQ2d 1542, 1544 (TTAB 1991). The earliest filing date of Applicant's applications is September 21, 2007. Applicant also claims that it first used its mark EXP in 2002 on a wide variety of goods, and the evidence shows that Applicant used its mark in 2002 on a Buddha figurine and on a tribal mask. However, even assuming that Applicant first used its mark in 2002 on all of the goods and services recited in its applications, Opposer's use predates this date, as Opposer's testimony establishes that Opposer first used its mark EXP in the 1980s²⁴ on clothing such as tops, bottoms, t-shirts, and sweatshirts as well as in advertising and direct mailings of Opposer's retail store services.²⁵

Applicant asserts that Opposer abandoned its EXP mark in 1996 and did not resume use until 2009.²⁶ Applicant attempts to prove Opposer's abandonment of the mark by introducing "Schedule A," prepared by Opposer's counsel during discovery. Schedule A is a chart listing the documents Opposer produced in order to demonstrate use of the mark EXP, arranged chronologically by year.²⁷ Applicant introduced Schedule A during Mr. Campbell's testimony deposition. Applicant claims that because the listing shows no use of the EXP mark for the years 1998–2001 and 2003–07, Opposer abandoned the mark.

²⁴ DeCarlo Test., p. 7, 65 TTABVUE 10 (the EXP mark was first used "about 1986 or so"); Focht Test., p. 8, 63 TTABVUE 11 ("I, again, joined in '92, and it was in full implementation at that point").

²⁵ Campbell Test., p. 18, 62 TTABVUE 21, Focht Test., p. 12, 63 TTABVUE 15.

²⁶ Applicant's Brief, p. 11, 74 TTABVUE 18.

²⁷ Applicant's Exhibit 2, 62 TTABVUE 314.

We note that Applicant did not plead abandonment. We further find that Applicant's line of questioning regarding the dates that were listed in Schedule A and the fact that the witness saw no entry for certain years was insufficient to put Opposer on fair notice that Applicant intended to assert that Opposer abandoned the EXP mark. However, although Opposer objected to the characterization that Applicant's counsel applied to the data, Opposer did not object to the admissibility of the schedule, and in reply to Applicant's brief, wherein Applicant requested that we find Opposer's mark EXP to have been abandoned, Opposer, while noting that Applicant did not plead abandonment, also argued against such a finding. Thus, to the extent the parties tried the issue of abandonment by implied consent under Fed. R. Civ. P. 15(b),²⁸ we find the evidence fails to establish that Opposer abandoned the mark EXP or that Opposer intended not to resume use during any of the alleged periods of non-use. The data contained in Schedule A is unverified, and not only did Mr. Campbell not authenticate the data during his deposition, he expressly noted he had never seen it before and did not contribute to "this data that is being used."²⁹ Any suggestion that Opposer discontinued use of the EXP mark, created by the lack

²⁸ Fed. R. Civ. P. 15(b) provides, in pertinent part, that when issues not raised by the pleadings are tried by express or implied consent of the parties, they shall be treated in all respects as if they had been raised in the pleadings. "Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. There must be no doubt that the nonoffering party was aware that the issue was being tried." TBMP § 507.03(b) (2014). *See also, Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 (TTAB 1998) (applicant did not object to testimony but was not fairly apprised that evidence, which also related to existing claim, was being offered in support of unpleaded claim); *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683 (TTAB 1984) (no basis for treating abandonment as having been tried by implied consent).

²⁹ Campbell Test., p. 122, 62 TTABVUE 126.

of entries on the schedule for some years, is amply rebutted by the testimony and evidence submitted by Opposer in support of its continuous use of the mark.

Moreover, because Applicant did not plead abandonment as an affirmative defense, Opposer is only required to show that its mark was “previously used in the United States...and not abandoned.” Trademark Act Section 2(d). *See also West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1665 (Fed. Cir. 1994) (“The governing statute does not speak of ‘continuous use,’ but rather of whether the mark or trade name has been ‘previously used in the United States by another and not abandoned.’”). Nonetheless, Opposer has shown continuous use of the EXP mark since the 1980s.

One of the earliest examples of Opposer’s use may be seen in Exhibit 34 to Mr. Focht’s testimony. Mr. Focht testified that “from the late ‘80s,” the EXP “wings and stars” mark³⁰ appeared on the cashwrap (“the desk where the registers are”³¹), a wall mural and a sculpture piece inside Opposer’s retail stores (as shown below).³²

³⁰ The EXP “wings and star” mark



is the subject of Opposer’s expired Reg. No. 1539267.

³¹ Focht Test., p. 187, 63 TTABVUE 189 (“It’s where the customer checks out, completes their purchase.”)

³² Focht Test., p. 10, 63 TTABVUE 13. The exhibit pages are at 64 TTABVUE 207-10.



Mr. Focht further testified that “we actually have a store in the field that still has the marks on the wall.”³³ The store was identified by Mr. Campbell as being located in Alexandria, Louisiana and as having maintained continuous use of the EXP “wings and stars” mark to the present.³⁴ A series of bounceback coupons³⁵ with the EXP “wings” mark³⁶ were identified by Mr. Focht as having been given or mailed to customers in 1987, 1988, 1989 and 1990,³⁷ and gift certificates bearing the EXP wings mark for purchases to be made in 1992 were mailed to customers in December of 1991.³⁸ Opposer also used its EXP mark on clothing and fashion accessories since the 1980s. The “wings and stars” EXP mark was directly affixed to garments.³⁹ The cashwrap photo of Exhibit 34 pictures a display stand of

³³ Focht Test., p. 10, 63 TTABVUE 13.

³⁴ Campbell Test., p. 147-48, 62 TTABVUE 150-51.

³⁵ Bounceback coupons are coupons “given to the customer to come back at a later date and shop again.” Focht Test., p. 19, 63 TTABVUE 22.

³⁶ This mark is identical to the EXP wings and stars mark, minus the two stars positioned above and below the wording “EXP.”

³⁷ Focht Test., p. 36-44, 63 TTABVUE 39-46; Exhibits 44-47, 63 TTABVUE 318 (Exhibit 44), 321 (Exhibit 45), 335 (Exhibit 46), 350 (Exhibit 47).

³⁸ See Exhibit 48, 63 TTABVUE 394; Focht Test. p. 46, 63 TTABVUE 49.

³⁹ Focht Test., p. 12, 63 TTABVUE 15.

accessories, including earrings, that were advertised by in-store sign holders that Mr. Focht stated “were attached to our accessory tower, probably a vertical sign holder.”⁴⁰ Exhibit 35 contains photographs of store interiors “from approximately 1980 to 1990”;⁴¹ in one photo there is a duffle bag bearing the EXP “wings and star”



mark.⁴² The EXP mark continued to be displayed on clothing during the 1990's, as shown by the following page taken from a credit card insert that Mr.



Focht identified as having been in stores in 1994.⁴³ In 1996, the EXP



mark also appeared on the undersole of shoes:⁴⁴ In 1998, the EXP mark was woven into the label on the coin pocket of women's jeans, which were sold by



Opposer (as depicted in an in-store sign from that time frame):⁴⁵

⁴⁰ Focht Test., p. 17, 63 TTABVUE 20; Exhibit 36, 63 TTABVUE 248.

⁴¹ 64 TTABVUE 16.

⁴² 64 TTABVUE 19.

⁴³ Focht Test., p. 61, 63 TTABVUE 64; Exhibit 51, 63 TTABVUE 534.

⁴⁴ Focht Test., p. 75, 63 TTABVUE 78; Exhibit 53, 64 TTABVUE 67.

⁴⁵ Focht Test., p. 32, 63 TTABVUE 35; Exhibit 55, 64 TTABVUE 100.

Point-of-purchase advertising for handbags was also disseminated in 1998 under



the EXP mark:⁴⁶ In the 2000's, Opposer continued use of the EXP mark on graphic t-shirt designs.⁴⁷ During 2005 through 2008, Opposer also used the mark EXP on accessories such as cuff links and belt buckles.⁴⁸ Opposer launched a website in 2008 under the mark EXPLife,⁴⁹ and a line of active sportswear under the mark EXP CORE in 2013.⁵⁰

Based on the foregoing, Opposer has demonstrated its continuous use of the mark EXP on clothing and fashion accessories and in association with retail store services since the late 1980s. Opposer has priority with respect to the EXP mark under the common law on goods and services identified in classes 18, 25 and 35.

Likelihood of Confusion

We address the question of likelihood of confusion on a case-by-case basis. That is, we will examine each of the pending oppositions in turn to determine if a

⁴⁶ Focht Test., p. 131, 63 TTABVUE 134; Exhibit 55, 64 TTABVUE 104.

⁴⁷ Schwartzberg Test., p. 12, 66 TTABVUE 15; Exhibits 62 and 66, 66 TTABVUE 106 and 110 (Exhibits filed under seal).

⁴⁸ Schwartzberg Test., pp. 16 and 21, 66 TTABVUE 19, 24; Exhibits 65 (66 TTABVUE 109) and 56, 64 TTABVUE 113 (Exhibits filed under seal).

⁴⁹ Campbell Test., p. 42, 62 TTABVUE 45.

⁵⁰ Focht Test., pp. 103 and 118, 63 TTABVUE 106, 121; Exhibit 25, 62 TTABVUE 294 (Exhibit filed under seal). The issue of tacking does not arise with respect to these two "EXP"-derivative marks because they were not in use until well after Opposer commenced use of the mark EXP.

likelihood of confusion exists. Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see also In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Opposition No. 91194918

In Opp. No. 91194918, Applicant seeks to register the mark EXP in three International classes: 3, 18 and 25. In our analysis, we will first consider the issue of likelihood of confusion with respect to the mark most similar to that of Applicant, namely, Opposer’s mark EXP. There is no dispute that Opposer’s mark EXP is identical to Applicant’s mark EXP in appearance, pronunciation, connotation and commercial impression. However, Applicant argues that the mark EXP is weak and should be given a narrow scope of protection because “exp” is the prefix or starting element to many words in the English language. In support, Applicant has submitted copies of third-party registrations of marks comprising the term EXP (as

a single term) and copies of registrations comprised of terms that start with the letters “e-x-p” such as EXPLORER, EXPEDIA and EXPEDITION.

The third-party registrations submitted by Applicant do not support Applicant’s contention that the mark EXP is weak. Applicant has not shown that any of the third-party marks are in use. It is well-established that absent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office). Moreover, as for the single-term EXP marks, with the exception of CARBON EXP for luggage, the registrations are for unrelated goods or services.⁵¹ *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (finding third-party registrations to be of limited probative value because the goods identified in the registrations “appear to be in fields which are far removed from [the goods at issue]”). *See also Key Chemicals, Inc. v. Kelite Chemicals Corp.*, 464 F.2d 1040, 175 USPQ 99, 101 (CCPA 1972) (“Nor is our conclusion altered by the presence in the record of about 40 third-party registrations which embody the word “KEY”. The great majority of those registered marks are for goods unrelated to those in issue, and there is no evidence that they

⁵¹ Reg. No. 2978765 for the mark EXP EDITION (stylized) for bags and cases in Class 18 and clothing in Class 25 is irrelevant to the issue because it is not based on use, but issued under Section 66, 15 U.S.C. § 1141(f).

are in continued use. We, therefore, can give them but little weight in the circumstances present here.”).

The mark CARBON EXP is itself distinguishable from Applicant’s mark on the basis of the term “carbon.” As for the third-party registrations for marks that start with the letters “e-x-p,” only one is for the mark EXPRESS, and it is for liquid detergent, goods not related to either parties’ goods or services.

Finally, the fact that other words that begin with “e-x-p” have been registered does not show that consumers will be unable to perceive that Opposer’s mark EXP is an abbreviation for EXPRESS. Indeed, Opposer has shown that the relevant purchasing public of clothing and fashion accessories is likely to consider “EXP” to be a shortening of the longer word EXPRESS, and that the term EXP is inherently distinctive for the goods involved. The record evidence shows that Opposer has used the contraction “to imply Express in an abbreviated way when used on marketing materials, garment marketing, labeling”⁵² for nearly 30 years. Customers have become familiar with the short-form version of EXPRESS, i.e., “EXP,” as identifying Opposer as the source of Opposer’s goods in various ways. There is a “bifurcated” version of the EXPRESS mark used on gift cards and store carriers (shopping bags) that emphasizes the contraction of EXPRESS to EXP.⁵³ In this format, the EXP sits on top of the remainder of the word (PRESS), with only half of the “p” and the final “s” showing. This stylized version has been “used for many years and in many

⁵² Focht Test., p. 9, 63 TTABVUE12.

⁵³ See Opposer’s Exhibit 21, 62 TTABVUE 284.

places”⁵⁴ including on “T-shirts and garments” and in a “variety of marketing elements in recent years.”⁵⁵ The mark EXP also appears in connection with Opposer’s mobile application for use on iPhone and Android devices,⁵⁶ in a text message⁵⁷ and through use of the marks “EXP Core” and “EXPLife.”⁵⁸ In these ways, Opposer’s customers have become familiarized with the letter-string “EXP” as standing for “EXPRESS.”

In similar circumstances, it has been found that consumers will shorten or abbreviate trademarks. “[U]sers of language have a universal habit of shortening full names – from haste or laziness or just economy of words. Examples are: automobile to auto; telephone to phone; necktie to tie; gasoline service station to gas station.” *In re Abcor Development Corp.*, 588 F.2d 511, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring).

[C]ompanies are frequently called by shortened names, such as Penney’s for J.C. Penney’s, Sears for Sears and Roebuck (even before it officially changed its name to Sears alone), Ward’s for Montgomery Ward’s, and Bloomies for Bloomingdales.

Marshall Field & Co. v. Mrs. Fields Cookies, 25 USPQ2d 1321, 1333 (TTAB 1992).

See also Giant Food, Inc. v. Nation’s Foodservice, Inc., 710 F.2d 1565, 218 USPQ

⁵⁴ Campbell Test., p. 57, 62 TTABVUE 60.

⁵⁵ *Id.*, p. 58, 62 TTABVUE 61.

⁵⁶ *Id.*, p. 59-60, 62 TTABVUE 62-3; Exhibits 23 and 24, 62 TTABVUE 290, 292.

⁵⁷ *Id.*, p. 54, 62 TTABVUE 57; Exhibit 18, 62 TTABVUE 239 (Exhibit filed under seal because it is addressed to a named individual. However, Mr. Campbell described the message as an initiative to Opposer’s “customer database”; thus the message is considered publically available. Campbell Test., p. 54, 62 TTABVUE 57).

⁵⁸ *Id.*, p. 55, 62 TTABVUE 58.

390, 395 (Fed. Cir. 1983); *Big M Inc. v. The United States Shoe Co.*, 228 USPQ 614, 616 (TTAB 1985).

Because EXP has been shown to be inherently distinctive and not diluted, it is considered a strong mark and the first *du Pont* factor strongly favors a finding of likelihood of confusion.

We next direct our attention to the second *du Pont* factor regarding the similarity/dissimilarity between the goods. Opposer has shown prior use of its mark EXP for dresses, jackets, pants, shirts, and skirts, as well as shoes, purses and duffel bags. Because these goods are listed in classes 18 and 25 of Applicant's application, there is a direct overlap of the involved goods. While Applicant's clothing is identified as "ethnic," there is nothing in the record to clarify the meaning of the term or to explain the distinction, if any, between ethnic clothing and other types of clothing. Accordingly, the goods are in-part identical in these classes. To the extent the goods are not identical, we find they are otherwise competitive or closely related. Accordingly, the second *du Pont* factor strongly favors a finding of likelihood of confusion in these classes.

We also find that the parties' respective goods will travel through the same channels of trade to the same classes of consumers. Mr. Altschuler stated that Applicant "is the manufacturer, the importer, the brand name, the wholesaler and the retailer. So we cover the whole vertical chain here."⁵⁹ Opposer sells through retail stores and online through its website. Hence, there is an overlap of trade

⁵⁹ Altschuler Test., p. 70, 70 TTABVUE 72.

channels. However, because Applicant does not sell through any distribution network other than the Internet, we accord the third *du Pont* factor lesser weight. Advertising on the Internet is ubiquitous and proves little, if anything, about the likelihood that consumers will confuse similar marks used on such goods or services. *Cf. Squirtco v. Tomy Corp.*, 212 USPQ 304, 307 (TTAB 1981) (“The fact that opposer’s and applicant’s goods may be found in some of the same stores is not controlling on this question. It is well recognized that there are a number of commercial establishments where one can find a myriad of different items.”); *Faultless Starch Co. v. Sales Producers Associates, Inc.*, 185 USPQ 824, 825 (TTAB 1975), *aff’d*, 530 F.2d 1400, 189 USPQ 141, 143 (CCPA 1976).

Because Applicant’s mark is identical to Opposer’s EXP mark and the goods for which Applicant intends to use its mark are in-part identical to those in connection with which Opposer is using its EXP mark and travel through at least some of the same trade channels, there is a likelihood of confusion should consumers familiar with Opposer’s goods encounter Applicant’s goods in classes 18 and 25.

Turning to Class 3, the first *du Pont* factor again favors Opposer in that the EXP marks are identical. However, while Opposer has shown that it sells personal care products such as fragrances and colognes under the EXP and EXPRESS marks,⁶⁰ Opposer does not sell products for perfuming the atmosphere, which are the goods covered by Applicant’s application: “scented room sprays; aromatic oils, namely, scented oils used to produce aromas when heated; potpourris and perfumed incense;

⁶⁰ Opposer also owns Reg. No. 4016278 for the mark EXPRESS, which covers retail store services featuring, *inter alia*, personal care products.

sachets.” Although the parties’ respective goods need not be identical or competitive, or even be offered through the same channels of trade to support a holding of likelihood of confusion, the goods must be shown to be related in some manner, or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993). Opposer has not shown that its line of personal care products or retail stores featuring such personal care products are related to Applicant’s scented room products or that they are marketed in such ways as to give rise to the mistaken belief that the parties’ respective goods originate from the same source. There is also nothing in the record to show that Opposer is likely to bridge the gap between the two types of goods and expand into the field of household fragrances. Indeed, Applicant owns Reg. No. 4071469 for the mark EXP for “scented and unscented candles; scented wax for use in candles warmers,” and these goods are related to those in Applicant’s present application.⁶¹ For these reasons, the second *du Pont* factor favors Applicant in Class 3. The third *du Pont* factor also favors Opposer as the trade channels overlap. On balance, we do not find a likelihood of confusion exists between Opposer’s EXP mark and Applicant’s EXP mark in Class 3.

⁶¹ Reg. No. 4071469 for the mark EXP for “scented and unscented candles; scented wax for use in candle warmers,” registered December 13, 2011.

We next consider whether there is a likelihood of confusion in Class 3 on the basis of Opposer's allegation that its EXPRESS mark is famous. "Fame, if it exists, plays a dominant role in the likelihood of confusion analysis" because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (fame is "a dominant factor in the likelihood of confusion analysis ... independent of the consideration of the relatedness of the goods."); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). "[F]ame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Bose Corp.*, 63 USPQ2d at 1305. Although raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (*e.g.*, the substantiality of the sales or advertising figures for comparable types of products or services). *Id.* at 1309. Other relevant factors include "length of use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark." *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012).

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

If Opposer can show that the EXPRESS mark is famous, Opposer's apparent lack of present intent to expand use of its mark to include such goods as scented room sprays would not be "an overriding consideration." *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981) (in finding MONOPOLY famous for a real estate board game, fact that its owner lacked interest in expanding to other product categories not considered significant factor in determination of public reaction to applicant's use of TUXEDO MONOPOLY).

In support of its contention that the EXPRESS mark is famous, Opposer has submitted confidential sales figures and supporting testimony for sales of goods sold under the mark EXPRESS since 1986. Opposer's use of the EXPRESS mark for nearly 30 years is a relevant factor in determining that its mark is famous. The fact that the dollar amount of sales shown by the sales figures is not insubstantial also favors Opposer. However, Opposer failed to introduce any specific evidence, even in approximate terms, regarding its share of the relevant market, the dates, scope, or nature of its advertising or other promotional expenditures, or to provide any evidence, such as declarations or articles, from customers or the media to suggest that the mark is well-known. On balance, we find that Opposer has established

considerable goodwill in the mark EXPRESS but not that it is a famous mark. Accordingly, while we find that Opposer's EXPRESS mark is not famous for purposes of likelihood of confusion, it is otherwise a strong mark entitled to a wide scope of protection.

We have carefully considered all of the evidence made of record pertaining to the issue of likelihood of confusion in Opp. No. 91194918, as well as all of the arguments related thereto, including any evidence and arguments not specifically discussed in this opinion. We conclude that purchasers familiar with Opposer's clothing and fashion accessories sold under the mark EXP would be likely to mistakenly believe, upon encountering Applicant's mark EXP for the identified goods in classes 18 and 25, that the goods originated from, are associated with or sponsored by Opposer. On the other hand, we conclude that confusion is unlikely on the basis of Opposer's marks EXP and EXPRESS with respect to the goods listed in Class 3.

Opposition No. 91199874

The goods involved in this opposition include the same goods in Class 3 of Applicant's application Serial No. 77286020 plus "joss sticks and scented wood."⁶² Our likelihood of confusion analysis based on Opposer's marks EXP and EXPRESS is not changed by the addition of these goods. The record does not contain any

⁶² A "joss stick" is a "stick of incense of the kind burned before a Chinese shrine or religious image." At <https://ahdictionary.com>, *The American Heritage Dictionary of the English Language* (5th Ed. 2014). The Board may take judicial notice of dictionary definitions of online dictionaries that exist in printed format or have regular fixed editions. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

evidence tending to show a relationship between perfume, fragrances or cologne applied to one's body and those designed to add aroma to a room or similar area. Accordingly, we conclude that confusion is unlikely on the basis of Opposer's marks EXP and EXPRESS with respect to the goods listed in Opposition No. 91199874.

Opposition No. 91199875

The goods involved in this opposition include the same goods in Class 18 as are listed in Serial No. 77286020 plus "canes and walking sticks." While there is no specific evidence showing that canes and walking sticks are related to those types of luggage on which Opposer has shown it uses the mark EXP, Opposer has shown prior use of the mark EXP on at least some of the exact goods listed in Applicant's application that is the subject of this opposition, namely, purses and duffel bags. Thus, we need not rely on a specific showing that canes and walking sticks are related to Opposer's goods. As the marks are identical, and the goods in-part identical, we conclude that confusion is likely on the basis of Opposer's mark EXP with respect to the goods listed in Opposition No. 91199875. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application).

Opposition Nos. 91198762 and 91209980

These oppositions will be considered together because they cover intrinsically related services. Applicant's application Serial No. 77799392 covers retail store services, on-line ordering services and advertising, marketing and promotion services directed to "the field of bags, furniture, home décor, jewelry, purses, and

watches.” Applicant’s application Serial No. 85668535 covers on-line wholesale store services and wholesale ordering services directed to “furniture, home décor, bags, clothing, footwear, headgear, jewelry, purses, watches, cushion covers, scented oils, hair accessories, personal care products, wall decor, socks vases, rugs and candles.”

As can be seen, the items listed in Applicant’s application as being sold by Applicant at retail and at wholesale are in-part identical. Applicant directs each of its enumerated wholesale and retail services to providing various items including “bags,” “jewelry,” “purses,” and “watches.” Its wholesale services further include “hair accessories” and “personal care products.” Opposer has shown that it has sold similar products, namely, bags, jewelry, purses, watches, hair accessories and personal care products under the EXPRESS and EXP marks. In addition, Opposer operates “brick-and-mortar,” as well as online, retail clothing and fashion accessory stores under the EXPRESS and EXP marks. Because both parties offer the same services featuring in-part identical goods under the identical mark EXP, a likelihood of confusion exists with respect to the services. The first and second *du Pont* factors favor Opposer in this opposition. Regarding channels of trade, Applicant has not shown that it sells over any distribution channels other than through the Internet, either as a retailer or wholesaler, or that it segregates its sales or advertising by group. Since both parties sell online over the Internet, the third *du Pont* factor also favors Opposer. There is a likelihood of confusion between the marks, when used in association with the specified services in Class 35.

Application Serial No. 85627524 (Opposition No. 91208967)

The application being opposed in this opposition is for the mark EXP for: “Fashion information; Online social networking services provided through a fashion community website; Providing news and information in the field of fashion; Provision of a web site featuring information on fashion.”

Opposer has shown prior use of its mark EXP for fashion-related goods and services. It also holds Reg. No. 4030937 for the mark EXP PERK for “downloadable software in the nature of a mobile application for providing links to third-party computer servers for the purpose of allowing users to receive retail promotions in the field of men’s and women’s clothing, consumer coupons, notice of retail clothing events and earn and redeem rewards by ordering clothing online.” We note that priority is not at issue with respect to Opposer’s EXP PERK mark as to the goods listed in the registration. The marks are similar in appearance, pronunciation and connotation. Opposer’s mark fully incorporates Applicant’s mark in its entirety, adding the term “PERK.” A “perk” is defined as “something extra that someone receives in addition to regular pay for doing a job” and, more broadly, as “a good thing that you have or get because of your situation.”⁶³ *Cf. Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1471 (TTAB 2014) (“The evidence of third-party use shows that the term ‘perks’ has been extended to describe not only employee benefits, but also benefits provided to a person in order to induce him into a commercial relationship (for example, as a customer or as a member of an organization) or provided as a reward in order to build loyalty among

⁶³ At <http://www.merriam-webster.com/dictionary/perk>.

existing customers or members.”). Purchasers who would encounter the EXP mark in association with Applicant’s identified fashion services and are familiar with Opposer’s EXP PERK mark are likely to believe that Opposer offers a bonus service or customer loyalty service as an enhancement of the EXP brand. Regarding Applicant’s services of providing fashion information, providing news and information in the field of fashion, and providing a website that features fashion information, these are in part legally identical to the “notice of retail clothing events” provided via Opposer’s downloadable software under its registered mark EXP PERK. Accordingly, the first and second *du Pont* factors favor a finding of likelihood of confusion. The trade channels also overlap in that Applicant provides its services via a website while Opposer offers a mobile application by which its customers may earn rewards that can be redeemed online via Opposer’s website. *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) (“Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.”). Based on the similarity of the marks, the relatedness of the goods and services and their trade channels, we find that a likelihood of confusion exists between Applicant’s EXP mark and Opposer’s EXP PERK mark.

Dilution

Opposer’s pleaded claim of dilution requires proof of fame of the mark EXPRESS. Because we have found that Opposer’s mark is not famous for purposes

of likelihood of confusion, it would not be famous for purposes of dilution. Fame for dilution purposes requires a more stringent showing. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). Accordingly, the claim of dilution is dismissed.

Decision:

Opposition No. 91194918 is sustained under Section 2(d), 15 U.S.C. § 1052(d), with respect to International Classes 18 and 25 only. The application will be forwarded to the Intent-to-Use Unit for processing of a notice of allowance in International Class 3.

Opposition No. 91198762 is sustained under Section 2(d), 15 U.S.C. § 1052(d).

Opposition No. 91199874 is dismissed. The application will be forwarded to the Intent-to-Use Unit for processing of a notice of allowance.

Opposition No. 91199875 is sustained under Section 2(d), 15 U.S.C. § 1052(d).

Opposition No. 91208967 is sustained under Section 2(d), 15 U.S.C. § 1052(d).

Opposition No. 91209980 is sustained under Section 2(d), 15 U.S.C. § 1052(d).